



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,206	02/11/2004	Michael J. Hubbard	OMNO-0010-1	9963

7590 05/05/2006

David G. Burleson
Chief Intellectual Property Counsel
OMNOVA Solutions, Inc.
175 Ghent Road
Fairlawn, OH 44333

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/775,206	Applicant(s) HUBBARD ET AL.	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The amendment filed July 8, 2004 is again objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: More particularly, the Examiner again notes that while he has no objection to the insertion of the term "pre-applied" which generally (but not always) refers to the adhesive layer throughout the specification in the manner applicants have done, nevertheless the believed at least twenty deletions of the term "peel and stick" from the specification are again respectfully submitted to be new matter, as the substance of this particular limitation (which is clearly not synonymous with the deleted terms) appears to have been lost from at least one of the embodiments that it formerly described in the specification. As to applicants' brief reply (Response, page 10, bottom) that the issue of new matter is "moot", without any accompanying discussion, the Examiner can only respectfully disagree. .

Applicant is required to cancel the new matter in the reply to this Office Action.

3. Claims 1,4-10 and 13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over newly relied upon Fisher. Note particularly the Abstract, Col 1, lines 7-28, line 64-col 2, line 9, lines 30-44, lines 58-65, Col 6, lines 30-56. Note that the reference has a filing date of 4/11/2002, and that although the term "dead load shear capable adhesive" is not taught, a broad genus of adhesives (along with the accompanying nominal method claim of independent claim 9)

which are believed to meet the limitations set forth, e.g. in the specification at page 8, including those based on block copolymers such as SEBS, are either clearly taught or are at most obvious optimizations to one of ordinary skill.

4. Claims 2,3,11,12, and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher. The reference is again relied upon as set forth above, and with respect to such additional limitations as the nominal independent method claims 14 and 18 note that the claimed methods require little more than applying the adhesive coated thermoplastic membrane onto a desired, i.e. building substrate. As regards the "flashing" claims including article claim 17 note again Futamura as evidence of the state of the art, as set forth in Paragraph No. 7 of Paper No. 092205, together with the fact that both a flashing and a membrane can have essentially identical structures, with the proper characterization thereof being essentially a determination of the article's method of use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday – Thursday - from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 – 272 - 1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 1771

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
Art Unit 1771

A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive, flowing style.